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Date: 06/20/2005**To:** Director TC 1700

(Petition)

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Cover Sheet + 3 Pages**Message:**

RE: Patent Application No.: 10/808,264

Filed: 03/17/2004

Inventor: Keller et al.

Docket No.: NC 96,200

Petition for Withdrawal of Finality of Office Action and for Reconsideration of

Applicants' Previous Response – 3 pages

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PATENT APPLICATION
Docket No.: NC 96,200

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of: Keller et al.

Serial No.: 10/808,264

Filed: 03/17/2004

For: OLIGOMERIC HYDROXY ARYLETHER PHTHALONITILES AND SYNTHESIS
THEREOF

Examiner: Truong, Duc

Art Group Unit: 1711

Honorable Commissioner of Patents
PO Box 1450
Alexandria, VA 22313-1450

June 20, 2005

PETITION FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION AND FOR
RECONSIDERATION OF APPLICANTS' PREVIOUS RESPONSE

Sir:

This petition is filed pursuant to 37 CFR § 1.181 and MPEP 706.07(c) and 1002.02(c)(3)(a). Applicants respectfully request that the finality of the office action of 05/16/2005 be withdrawn and, in the alternative, that the entire office action be withdrawn and the application reconsidered in light of Applicants' amendment of 03/03/2005. Under MPEP 1002.02(c)(3)(a), a petition to withdraw finality is decided by the Technology Center Director.

STATEMENT OF FACTS

This application is a divisional application of U.S. Patent Application number 10/135,012 filed on 04/26/2002, now US Patent 6,756,470. The application was filed on 03/17/2004 with a preliminary amendment canceling some claims, amending the remaining independent claims (1, 3, 22, 24, and 26), and adding new claims (all papers are viewable in the image file wrapper). A non-final office action was mailed on 11/29/2004 stating rejections under 35 U.S.C. § 102(b) and 103(a). Applicants responded on 03/03/2005 by amending claims 3, 22, 24, and 26 and by providing arguments and a declaration. Claim 1 was not amended in this response.

CERTIFICATE OF FACSIMILE TRANSMISSION

I certify that this correspondence is being facsimile transmitted to the US Patent and Trademark Office on the date shown below.

6/10/05
Date


Joseph T. Grunkemeyer

Serial No.: 10/808,264

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On 05/16/2005, a final rejection was mailed. The office action included a new ground of rejection of all the pending claims under 35 U.S.C. 112, first paragraph for alleged lack of enablement, and stated that Applicants' amendment necessitated the new ground of rejection. (p. 3, lines 16-17.) The rejection concerns the limitation "with or without substituents containing one or more fused aromatic rings, one or more non-fused aromatic rings without intervening functional groups, or combinations thereof wherein the radical sites are on the same or different aromatic rings." This limitation was present in claims 1 and 3 at the time of the non-final action and was added by amendment to claims 22, 24, and 26 in response to the non-final action.

The final rejection also states that the amendments to claims 1, 3, 22, 24, and 26 raised new issues that would require further consideration and search. (p. 2, lines 15-17.) The final rejection also states that claim 3 is subjected to a new matter situation (as opposed to a new issue). (p. 3, line 9.) However, claim 1 was not amended, and the final rejection nowhere states that entry of the amendment was denied.

By telephone interview of 06/02/2005, the Examiner agreed to reconsider the finality of the rejection. At the time of filing of this petition, the PAIR database showed no activity in the case.

A similar petition is being filed at the same time in U.S. Patent Application number 10/808,266, which is also a divisional of the same parent application as the present application.

ARGUMENT

The Examiner affirmatively stated that the amendment was the basis for the finality of the rejection. However, the rejection included a new enablement rejection not made in the previous action. The rejection concerned a claim limitation that was present in claims 1 and 3 when the application was first examined. Under MPEP 706.07(a), "second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement." No IDS was filed with the previous amendment. Since the disputed limitation was present in claims 1 and 3 for the first examination, the new rejection was not necessitated by Applicants' amendment. The rejection should not be a final rejection.

Additionally, it is not clear whether the amendment of 03/03/2005 was considered. The Examiner stated that the amendment raised new issues that would require further consideration

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and search. This language is usually used to deny entry of an amendment after a final rejection. However, the amendment was in response to a non-final rejection and would appear to have been entered. As the merits of the amendments were not addressed in the final rejection, it appears that the presently pending claims were not examined. The entire office action should be withdrawn and the pending claims reexamined.

Therefore, Applicants respectfully request that the finality of the office action be withdrawn and, in the alternative, that the entire office action be withdrawn and reconsidered.

37 CFR § 1.181 does not specify a fee for this petition. However, in the event that a fee is required, please charge the fee to Deposit Account No. 50-0281, and in the event that there is a credit due, please credit Deposit Account No. 50-0281.

Respectfully submitted,



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